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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,150	07/03/2001	Dietmar Uhde	PD000032	2593

7590 08/23/2005

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT PAPER NUMBER

2655

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/898,150

Applicant(s)

UHDE ET AL.

Examiner

Jorge L. Ortiz-Criado

Art Unit

2655

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 22-39.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

W. R. YOUNG
PRIMARY EXAMINER

Continuation of 3. NOTE: Newly introduced limitations in claims 28 and 38, would require further considerations of the prior art of record, further considerations under 35 U.S. 112 basis and/or inherently new search.

Continuation of 11. does NOT place the application in condition for allowance because:
Response to arguments:

Applicants argues that Bakx reference absolutely does not teach, disclose or suggest, "the identification data of the inserted optical recording medium is read by said apparatus before said apparatus reaches a read readiness state", "determining if adjustments values associated with parameters values for reading from and writing to the identified optical recording medium are accessibly stored for said apparatus", because Bakx reference discloses several examples of adjustment parameters (i.e. intensity, field strength, pulse width, speed) and where NONE of the these parameters influences the ability to READ, and do NOT even exist as adjustable parameters in READING as recognized by an EXPERT in the field.

And, where Bakx absolutely does not teach, disclose or suggest, the Applicant's invention, which upholds adjustments parameters like focus gain, focus offset, track gain, track, offset, and HF gain as taught in the Applicant's Specification, that directly influence READING, such that teachings of Bakx teach away from the Applicant's claimed invention.

The Examiner cannot concur with Applicant.

During patent examination, the pending claims are given their broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); See In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997) Bakx teaches wherein the identification data of the inserted optical recording medium is read by said apparatus before said apparatus reaches "a read readiness state/Optimum conditions" (see col. 5, lines 31-61; col. 6, lines 34-35; step A11, A12, A14 are performed in a non-optimum conditions /before read readiness state, time while the adjustments using the parameters have NOT being made, NOT Optimally Adjusted etc.)

Bakx discloses and teaches reading from and writing the identified optical recording medium which specifically discloses a READ/WRITE head # 3 as in Fig. 1, and where a write means (i.e. elements # 3, #8 in Fig. 1) are Optimally Adjusted depending on the Identification data Read, determining if adjustments values ASSOCIATED with parameters values for reading from and writing to the identified optical recording medium are accessibly stored for said apparatus, in that, as acknowledged by Applicant, Bakx teaches several adjustments parameters (i.e. intensity, field strength, pulse width, speed) and at Very Least the Adjustment parameter of light Intensity, directly influences the ability to READ as well as of WRITE, and it would be UNERSTOOD to one of ORDINARY SKILL IN THE ART, see for example references made of record in 04/07/2004, 12/23/2004, Massakawa U.S. Patent No. 5,155,719, U.S. Patent No. Suzuki 4,989,195), hence would have been understood to an EXPERT in the field as well.

Applicant is reminded that office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) Limitations appearing in the specification but not recited in the claim are not read into the claim. > E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).< In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies cited from the specification ("adjustments parameters of focus gain, focus offset, track gain, track, offset, and HF gain") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, prior art reference teaches away from claimed invention if it suggests that developments flowing from its disclosures are unlikely to produce objective of invention, and what reference teaches person of ordinary skill in art is not limited to what reference specifically "talks about" or what is specifically "mentioned" or "written" in reference. What a reference teaches a person of ordinary skill is not, as "Applicant's expert" appears to believe, limited to what a reference specifically "talks about" or what is specifically "mentioned" or "written" in the reference. Syntex (U.S.A.) LLC v. Apotex Inc., 74 USPQ2d 1823 (CA FC 2005); In re Gurley, 27 F.3d 551, 553 [31 USPQ2d 1130] (Fed. Cir. 1994)..